UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ART UNIT	PAPER NUMBER
2165	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)	
Office Action Summary	10/075,283	IWAYAMA ET AL.	
	Examiner	**Art Unit**	
	Neveen Abel-Jalil	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 June 2007</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>10-18</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>10, 16, and 18</u> is/are rejected.

7)☒ Claim(s) <u>11-15 and 17</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All   b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Remarks

1.   In response to Applicant's Amendment filed on June 7, 2007, claims 10-18 are pending

in the application.

2.   Applicant's amendment has overcome most of the previous rejections under 35 USC 112,

second rejection. However, claim 16 remains rejected under 112, second paragraph for

confusing language.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

4.   Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

Applicant's language in the last sentence of claim 16 is confusing, "sent by the client, to

the client" is vague and renders the claimed recitation to be indefinite. The "summary" is never

sent by the client in fact it was sent to the client. Corrections and/or clarifications are required.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 10, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singhal

(U.S. Patent No. 6,163,782) in view of Subramaniam et al. (U.S. Patent No. 5,859,972).

As to claim 10, Singhal discloses a service for searching documents wherein servers

comprising document databases and programs to manipulate said databases are dispersed over a

network and a client connected to said servers performs a document search, said service

providing a document search method comprising the steps of:

making a first search input of a set of keywords, fragments of a document or any desired

set of documents to a first document database (See column 4, lines 37-47),

conducting a first search of said first document database based in said first search input

(See column 4, lines 37-47);

retrieving at least one document as a result of said first search (See column 4, lines 51-

65);

inputting said at least one retrieved document to said first document database (See

column 5, lines 26-42, wherein "inputted" reads on "send back and stored");

making a weighted term list, whereby each term is given a weight ("whereby" is

interpreted as intended use clause and does actually cause any functionality to occur), from said

input of said at least one retrieved document to said first document database, the weight of each

term reflecting the importance of the term in the first document database (See column 2, lines

51-57), and

wherein said weighted term list is used as a second search input for performing said

search of said second document database (See column 5, lines 35-55), and

wherein each term in said weighted term list is given a weight based on an importance of

the term both in the first document database and the second document database, and the weight

of each term is used to calculate the relevance of each document of the second document

database (See column 3, lines 16-21); and

displaying result of said search on a display unit (See column 3, lines 13-21).

Singhal teaches the claimed invention but does not explicitly disclose automatically

conducting a second search of said second document database based on said second search input.

Subramaniam et al. teaches automatically conducting a second search of said second

document database based on said second search input (See column 8, lines 25-40).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have modified Singhal by the teaching of Subramaniam et al. to include

automatically conducting a second search of said second document database based on said

second search input because it allows for faster and more efficient access of two or selected

databases to be searched (See Subramaniam et al. column 2, lines 38-50)

As to claim 18, Singhal discloses a computer implemented service of searching

documents wherein servers comprising document databases and programs to manipulate said

databases are dispersed over a network and a client connected to said servers performs a

document search, said service providing a document search method comprising the steps of

the client transmits a set of documents in a first search input to a first one of said servers

where a first document database is stored, receives a summary comprising only topic words

related to the set of documents which is sent (See column 4, lines 37-47),

conducting a first search of said first document database based on said first search input

(See column 4, lines 37-47),

the client receiving back a summary containing only topic words resulting from said first

search (See column 5, lines 26-42, wherein "inputted" reads on "send back and stored"),

the client sending a second search input corresponding to said summary reflecting a user's

evaluation of the summary to a second server where a second document database is stored (See

column 5, lines 35-55),

the client receiving back a search result from said second search of the second document

database,

wherein said first server storing the first document database produces the summary of

topic words relevant to the set of documents sent by the client and transmits the summary to the

client, and searches and transmits to the client a set of documents having a high relevance to any

desired summary sent by the client (See column 3, lines 13-21).

Singhal teaches the claimed invention but does not explicitly disclose automatically

conducting a second search of said second document database based on said second search input.

Subramaniam et al. teaches automatically conducting a second search of said second

document database based on said second search input (See column 8, lines 25-40).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have modified Singhal by the teaching of Subramaniam et al. to include

automatically conducting a second search of said second document database based on said

second search input because it allows for faster and more efficient access of two or selected

databases to be searched (See Subramaniam et al. column 2, lines 38-50)

Allowable Subject Matter

7.   Although no rejections in view of prior art are made with regards to dependent claims 11-

17, no claims in this application will be indicated as allowable until after a response to this action

has been reviewed, as to the fact that certain changes many not produce allowable claims.

Response to Arguments

8.   Applicant's arguments filed on June 7, 2007 have been fully considered but they are not

persuasive.

In response to Applicant's argument that "Singhal and Subramaniam et al. do not each or

disclose second search input which maybe broader than the input of the first search…instead

both cited references teach the use of computer system where a single search input is directed to

plurality of databases " is acknowledged but not deemed to be persuasive.

The Examiner contends that the combination of Singhal and Subramaniam et al. does

teach the argued limitaion in Subramaniam et al. specifically in Figure 9A, Figure 11, and

column 10, lines 1-10, wherein allowing the user to select a database and run the same search

either using text or blast and modifying the query (i.e. second query) then viewing the combined

results is taught.

Applicant's disclosure pages 10-12 appears to describe the relevant support for the

argued limitation in the claims however, in the disclosure and specifically on page 11, lines 5-14,

explicitly states that "the more advanced search... is omitted from the preferred embodiment but

explained in Japanese Patent" hence making an afterthought and un-defined in the instant

disclosure. It is unclear to the Examiner what is being claimed in light of this disclosure and

more so since the Examiner does not speak Japanese, it is difficult to ascertain the support for

that additional options (i.e. broadening or narrowing search terms).

While, the disclosure on page 11, lines 20-28, instead provides for:

Subsequently, if the user is interested in handling other document data for the set of documents
corresponding to this search result, he may change the document database in the window MI, and press the button
B1 to begin a new search. Hence, the client sends an identifier of the 25 plural documents selected to the server
where the source document database is stored (for example, the server 13), obtains a summary of these plural
documents, sends this summary to the server where the target document database is stored (for example, the server
14), and obtains a search result from the target server (for example, the server 14). The new search result is
displayed in the window PI. In other words, in this case, PI is updated by the set of documents, which was newly
searched.

So in fact the new search is nothing more than a second search using the same original

input (i.e. single input) to a different database not different from what is clearly taught in

Subramaniam et al. Figure 5A, and column 9, lines 23-37.

It also appears that in light of Applicant's disclosure pages 6 and 10, that user interaction

is required to process and show the relevance of the first search query, and based on that

automatically processing a second search, which is completely missing from claim 1.

Note: servers are not claimed in claim 10, only in claim 18.

In response to applicant's arguments on pages 8-9 that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies (i.e.,

second search input, becomes a larger set of terms than the first search input...the second search

input would include terms not found in the first search input) are not recited in the rejected

claim(s). Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

9.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

10.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Driscoll (U.S. Patent 5,642,502) teaches original query is updated to second query

automatically under user's refinement.

Kirsch (U.S. Patent No. 5,659,732) teaches computing document ranking at the client for

multiple database documents.

Li et al. (U.S. Patent 5,911,138) teaches refining user's search.

Corey et al. (U.S. 5,987,446) teaches searching large collections of text using multiple

search engines.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074.

The examiner can normally be reached on 8:30AM-5: 30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neveen Abel-Jalil
August 8, 2007